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| APPLICATION NO.                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|---------------------|------------------|
| 09/819,351                        | 03/28/2001  | Katsumi Watanabe     | 14445               | 3348             |
| 23389                             | 7590        | 09/30/2005           | EXAMINER            |                  |
| SCULLY SCOTT MURPHY & PRESSER, PC |             |                      | STELLMAN, MARY J    |                  |
| 400 GARDEN CITY PLAZA             |             |                      | ART UNIT            |                  |
| SUITE 300                         |             |                      | PAPER NUMBER        |                  |
| GARDEN CITY, NY 11530             |             |                      | 2191                |                  |

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                              |                   |
|------------------------------|------------------------------|-------------------|
| <b>Office Action Summary</b> | Application No.              | Applicant(s)      |
|                              | 09/819,351                   | WATANABE, KATSUMI |
|                              | Examiner<br>Mary J. Steelman | Art Unit<br>2191  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 7/25/2005, 6/24/2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1-5 is/are allowed.  
 6) Claim(s) 6 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 March 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/2/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This Office Action is in response to RCE received 7/25/2005 and Remarks and Amendments received 6/24/2005. Per Applicant's request, claims 1, 3, and 6 are amended. Claims 1-6 are pending.

### ***Claim Objections***

2. Examiner objects to claim status indicated on claims received 6/24/2005. Claim 3 recites "(Previously Amended)" should be --(Currently Amended)--.

### ***Information Disclosure Statement***

3. Regarding IDS received 28 March 2001, Examiner has located English patent abstracts at the Japanese Patent Office, hereby included as references cited. As such, Examiner has initialed IDS received 1/2/2004.

### ***Allowable Subject Matter***

4. The following is a statement of reasons for the indication of allowable subject matter:

As Applicant has pointed out, on page 6 of Remarks received 6/24/2005, regarding independent claim 1, cited prior arts taken alone or in combination, fail to disclose:

"outputting an uncompressed instruction address as trace data when an instruction code of the instruction address/instruction code data from said CPU is a branch instruction;

outputting the uncompressed instruction address as the trace data when the section trace start signal from said event management means is active;

generating a plurality of compressed instruction addressed by compressing the instruction address of the instruction address/instruction code data, combining the compressed instruction addresses, and outputting the compressed instruction addresses as the trace data when the instruction address of the instruction address/instruction code data is not a branch instruction and the section trace start signal is not active”

It is important to note that the ‘section trace start signal from said event management means is active’ only during a brief 2-clock period at the start of execution of a section to be traced, as disclosed in the Specification, page 19, last paragraph.

Thus, claims dependent upon claim 1, claims 2-5, also contain allowable subject matter.

***Response to Arguments***

5. Applicant's arguments (filed 6/24/2005), with respect to claim 1 have been fully considered and are persuasive. The rejections of claims 1-5 have been withdrawn.
6. Applicant's argues that Edwards provides no suggestion of selectively compressing trace data. Examiner disagrees. Col. 10, lines 55-60 suggest that preconditions to triggering particular events may be provided in generating trace information. Edwards suggested that the trace may be compressed (col. 9, line 55).
7. Examiner disagrees with Applicant's comment on page 7, 4<sup>th</sup> paragraph, “Independent Claim 6 recites similar language to Claim 1.” In fact, claim 6 only applies to storing a ‘predetermined instruction address and a predetermined instruction code’ (such as a start trace

address) uncompressed. Claim 6 does not suggest the limitation of storing a branch instruction uncompressed.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,732,307 B1 to Edwards.

Per claim 6:

A program development support apparatus comprising:

-a trace memory for compressing and storing an instruction address that traces an instruction in a program;

Edwards disclosed (col. 2, lines 60-65) a debug module (program development support apparatus) configurable to store trace information. Edwards recognized the usefulness of compressing the trace information (col. 2, lines 41-58).

-event detection means for controlling to write an instruction address upon detecting at least one of a preset predetermined instruction address and a predetermined instruction code, of which at least one of the predetermined instruction address and the predetermined instruction code is

stored in said trace memory as uncompressed data, the predetermined instruction code being different from a branch instruction.

Edwards disclosed that some instructions/data code may (col. 9, line 55) be compressed. The type of instruction is detected and a decision is made, considering defined events and conditions defined, whether to compress or not (choose to not compress preset predetermined instruction address and a predetermined instruction code, different from a branch instruction). Edwards: col. 10, line 55-col. 11, line 3, "debug circuit may provide a number of signals to the processor for use in debugging operations...a number of bit values which operates as preconditions (signals, matches of predetermined code / addresses, certain types of instructions such a branch) to triggering particular events...These events may then generate trace information...watchpoint channels may cause the processor to generate ...an exception. The watchpoint channels themselves may also have preconditions (upon detecting at least one of a preset predetermined instruction address and a predetermined instruction code) which determine...match conditions which indicate whether or not a match will occur (a match of predetermined code / address?) for a particular watchpoint, and action conditions which will determine if and what type of action occurs (compress or not compress prior to storage?) based on a watchpoint channel match."

Edwards disclosed storing trace data at col. 6, lines 12-14.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned: 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

09/07/2005

A handwritten signature in black ink, appearing to read "Mary Steelman".